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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Hogan)
Serial No. 09/867,589)
Filed: May 31, 2001)
For: Electronic Bill and Non-bill Information)
Presentation)
Examiner: Havan, Thu Thao
Art Unit: 3624

APPLICANT'S APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Pursuant to 37 C.F.R. § 1.191 and M.P.E.P. § 1205, the Applicant submits this Appeal Brief to the Board of Patent Appeals and Interferences. This brief is in response to the Final Office Action mailed on March 23, 2006 and the Notice of Appeal transmitted by First Class Mail with a Certificate of Mailing date of June 23, 2006.

This Appeal Brief is timely filed within one month of the mailing of the Notice of Panel Decision from Pre-Appeal Brief Review. The Notice of Panel Decision from Pre-Appeal Brief Review mailed on August 25, 2006 reset the time period for filing an appeal brief to the greater of one month from the mailing date of the Notice of Panel Decision, or the balance of the two-month time period running from the receipt of the Notice of Appeal as provided in § 41.37. The

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 25, 2005.

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time period for filing the Appeal Brief is extendable under § 1.136(a) and (b) for up to five months after the two month time period. Also submitted herewith is the Appeal Brief fee of \$500.00 pursuant to 37 C.F.R. § 41.20(b)(2).

I. REAL PARTY IN INTEREST

This application is assigned to CheckFree Corporation. An assignment from the inventor to CheckFree Corporation was recorded with the Patent Office at Reel 012227 and Frame 0635 on October 2, 2001.

II. RELATED APPEALS AND INTERFERENCES

The Applicant is not aware of any related appeals or interferences.

III. STATUS OF CLAIMS

All pending claims, Claims 1-16 and 18-30 stand rejected. All claims are appealed herein. The claims are attached hereto in Appendix A.

IV. STATUS OF AMENDMENTS

No amendments were filed after the rejection in the Final Office Action of March 23, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present application is directed to techniques for electronic presentation of a bill and associated non-bill information via a network. A bill including a charge and a location identifier of non-bill information upon which the charge is based is transmitted to a payer via the network. Upon receiving a request for the non-bill information from the payer via the network, the requested non-bill information upon which the charge is based is transmitted to the payer via the network. For example, in one illustrative embodiment, an electronic bill for an insurance premium may be transmitted to a payer. The bill may include one or more location identifiers or targeted links that link to portions of the insurance contract upon which the bill charges are based. If the user selects one of the location identifiers, such as the location identifier associated with a charge for collision coverage, then the portion of the insurance contract pertaining to the payer's collision coverage will be electronically transmitted to the payer (Specification, Paragraph 52 and Figure 4A). The independent claims involved in the appeal are Claims 1, 9, 18, 23, 29, and 30.

Each of the independent claims of the present invention contain three steps or elements. First, a bill including a charge and a location identifier of a portion of non-bill information upon which the charge is based that is transmitted to a payer or user entity via a network. Next, a request is received from the payer or user entity for the portion of non-bill information. Then, the requested non-bill information upon which the charge is based is transmitted to the payer or user entity via the network.

The independent claims are directed to methods, systems, and articles of manufacture for presenting a bill and associated non-bill information via a network. One embodiment of the method is illustrated in Figures 4A and 5. With reference to Figure 5, an electronic bill is

transmitted to a payer or user entity 52 (Specification, Paragraph 55, lines 4-5). In independent Claims 1, 9, and 29, the transmitted bill includes a first charge, a second charge, a location identifier of first non-bill information upon which the first charge is based, and a location identifier of second non-bill information upon which the second charge is based (Figure 4A, Specification, Paragraph 52, lines 5-10). In independent Claims 18, 23, and 30, the transmitted bill includes a charge and a location identifier of a portion of non-bill information upon which the charge is based. Following the transmission of the bill to the payer or user entity, a request is then received from the user entity 52 via the network for at least one of the first non-bill information or the second non-bill information (Specification, Paragraph 55, lines 10-15). The requested non-bill information is then transmitted to the user entity 52 via the network in response to the received request (Specification, Paragraph 55, lines 15-22).

Claim 2, which is dependent from Claim 1, and Claim 10, which is dependent from Claim 9, further specify that the first non-bill information is a first portion of a document and the second non-bill information is a second portion of the same document (Specification, Paragraph 56, lines 1-28).

Claim 5, which is dependent from Claim 1, further claims that the bill, including the location identifiers to non-bill information are transmitted to the payer or user entity 52 by a bill presentment server and the non-bill information is transmitted to the user entity 52 by a non-bill presentment server (Specification, Paragraphs 59-61). Similarly, Claim 15, which is dependent from Claim 9, and Claim 27, which is dependent from Claim 23, specify that different servers transmit the bill information and the non-bill information to the user entity 52. In Claims 15 and 27, the bill information, including the location identifiers, is transmitted to a payer or user entity

52 by a network station associated with a bill payment service provider, and the non-bill information is transmitted to the user entity 52 by a network station associated with a biller (Specification, Paragraphs 59-61).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-16 and 17-30 are anticipated by U.S. Pat. No. 6,289,322 to Kitchen et al. (“Kitchen) under 35 U.S.C. § 102(b).

VII. BRIEF DESCRIPTION OF THE REFERENCE

As an initial matter, the Applicants would like to point out that the Kitchen patent cited by the Examiner is also assigned to the CheckFree Corporation. Accordingly, the Applicants are familiar with the teachings of the Kitchen reference.

Kitchen is generally directed to a method of electronically presenting billing information. Kitchen teaches receiving requests by payers for current billing information, responsive to which bill presentment information corresponding to the applicable portion of the billing information is transmitted to the requested payer.

A centralized bill processing system or CF station receives and stores billing information from billers (column 6, lines 20-28, 50-58). Summaries of the received billing information may also be generated and stored by the CF station (column 6, lines 59-64). Additionally, the CF station may merge the billing information with stored templates prior to electronically presenting bill presentment information to appropriate payers (column 6, line 64 – column 7, line 5). By combining the billing information with a template, an electronic bill may be presented that is in

substantially the same form, potentially including detailed billing information, biller logo, color, and terms and conditions, as has historically been provided to the payer by a biller in hardcopy form (column 6, line 64 – column 7, line 5).

Once the billing information has been processed by the CF station, an e-mail or other message is transmitted to an applicable payer informing him/her of the availability of a new bill (column 7, lines 6-16). Responsive to a request received from a payer, the CF station then transmits either bill summary information or an electronic bill to a payer (column 7, line 66 – column 8, line 37). After a payer receives bill presentment information, the payer may then request that payment of one or more bills be made to the appropriate billers by, for example, either electronic funds transfer or by hardcopy check (column 8, lines 52-67).

VIII. THE REJECTION

In the Final Official Action dated March 23, 2006, pending claims 1-16 and 18-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,289,322 to Kitchen et al. (“Kitchen”). The Examiner maintained his positions from the Non-final Office Action dated October 4, 2005. Claim 17 had been previously cancelled in an Amendment mailed on April 20, 2005 in response to a Non-final Office Action dated October 26, 2004, which cited art other than Kitchen.

Regarding independent Claims 1, 9, 18, 23, 29, and 30, the Examiner argues that personal information and login information such as a payer’s name and address constitute location identifiers of non-bill information upon which a charge is based. The Examiner points to column 3, lines 15-45 and to Figures 4-6, 9a, 10a, 11, and 14 of Kitchen to support his contention. The

Examiner then points to column 12, line 55 to column 13, line 47 and to Figures 7-8 to support his contention that Kitchen anticipates receiving a request from the payer for non-bill information. Finally, the Examiner relies on Figure 9a, which is a bill summary presentment page, to support his contention that Kitchen anticipates transmitting requested non-bill information to the payer.

Regarding dependent Claims 2 and 10, the Examiner argues that Kitchen discloses that first non-bill information is a first portion of a document and second non-bill information is a second portion of the same document. To support this contention, the Examiner points to Figures 4-6 and 11 of Kitchen. Figures 4-6 disclose enrollment screens used by a payer when first enrolling with the system disclosed by Kitchen and Figures 11 discloses a detailed bill presentment screen that outlines each of the charges from a biller.

Regarding dependent Claims 5, 14, and 26, the Examiner argues that Kitchen discloses that the location identifiers of non-bill information are transmitted to a payer by a bill presentment server; and the requested non-bill information is then transmitted to the payer by a non-bill presentment server. To support this contention, the Examiner points to Figures 8-9B of Kitchen, which all disclose screens transmitted to the payer by the bill presentment server of the CF station disclosed by Kitchen.

IX. GROUPING OF CLAIMS

For the purposes of this Appeal, the Appellants assert the separate patentability of the following groups of claims:

Group I: Claims 1, 3-4, 6-9, 11-14, 16, 18-26, and 28-30

Group II: Claims 2 and 10

Group III: Claims 5, 15, and 27

X. ARGUMENT

Appellants respectfully traverse the rejections based on the prior art applied against the claims now pending on appeal. As discussed below, it is respectfully submitted that the Examiner has not met the burden of proof in establishing that the appealed claims are anticipated, has failed to provide the required factual basis and reasonable rationale for the rejections, has failed to apply art which teaches or suggests the invention as claimed, has failed to properly construe the applied art, and has failed to consider all recited claim limitations.

1. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. In re Fine, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Paisecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in

the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

The Examiner must provide sufficient factual basis or rationale as to how features of the invention recited in the claims are taught or suggested in the applied art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). That is, objective evidence must be presented by the Examiner in support of the rejection. Without such support, the rejection is improper *per se*.

It is respectfully submitted that the Examiner has failed to establish a *prima facie* case for the rejection. More particularly, the Examiner has failed to provide objective support or reasonable rationale for the rejections, has ignored limitations recited in the claims, and has applied art in a manner inconsistent with its teachings.

A. THE EXAMINER ERRED BY FAILING TO RESPOND TO THE ARGUMENTS
MADE BY THE APPLICANTS

It should be noted that, in the Final Office Action, the Examiner failed to respond to the arguments made by the Applicants in response to the Non-final Office Action. In doing so, the Examiner completely ignored the claimed limitation that a transmitted bill include “a location identifier of non-bill information upon which a charge is based.” Accordingly, the Examiner has failed to demonstrate that each claimed limitation of the present invention is disclosed by Kitchen.

In the Final Office Action, the Examiner stated that the recitation of non-bill information has not given patentable weight because the recitation occurs in the preamble of the independent

claims (Final Office Action, Page 2). While it is true that the preamble of the independent claims does recite the term non-bill information, “non-bill information” is expressly recited in each of the elements of every independent claim. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. The Examiner’s argument that non-bill information should not be given patentable weight is in error because the term non-bill information is recited in each of the elements of the independent claims.

Additionally, by his later arguments, the Examiner clearly recognizes that non-bill information is an element of each of the independent claims that must be given patentable weight. As described in detail above, the Examiner points to several Figures of Kitchen to support his contention that non-bill information is disclosed. Accordingly, the Examiner’s contention that the recitation non-bill information should not be given patentable weight is in error.

Moreover, the Examiner’s arguments still fail to demonstrate that Kitchen discloses a bill that includes a charge and a location identifier of non-bill information upon which the charge is based. Following the Applicant’s response to the Non-Final Office Action, which argued that “nowhere does Kitchen teach the transmission of a bill including location identifiers of non-bill information upon which a bill charge is based” (Response to Office Action dated January 3, 2006, Page 2), the Examiner put forth no argument that Kitchen discloses a location identifier of non-bill information. Instead, the Examiner reiterated his earlier position that personal

information constitutes non-bill information. Even if this is true, the Examiner has failed to show that a bill transmitted to a payer includes a charge and a location identifier of non-bill information upon which the charge is based. Accordingly, the Examiner has failed to show that Kitchen discloses each and every element of the independent claims of the present application.

It should be apparent from the above that the Examiner has not established a *prima facie* basis for the rejection of independent Claims 1, 9, 18, 23, 29 and 30 in the Final Official Action. Because the Examiner has failed to demonstrate that Kitchen discloses all of the claim limitations recited in the independent claims of the present application, the Examiner's rejection is in error. Because the independent claims are patentable over the cited prior art, all of the dependent claims of the present application are allowable as a matter of law.

B. KITCHEN DOES NOT DISCLOSE THE TRANSMISSION OF A BILL
INCLUDING A CHARGE AND A LOCATION IDENTIFIER OF NONBILL
INFORMATION UPON WHICH THE CHARGE IS BASED

Each of independent Claims 1, 9, 18, 23, 29 and 30 require that a transmitted bill includes a charge and a location identifier of non-bill information upon which the charge is based. The Examiner has failed to show that Kitchen teaches the "transmission of a bill including a location identifier of non-bill information upon which a charge is based" (Response to Office Action dated January 3, 2006, Page 2).

In the Non-final Office Action dated October 4, 2005, the Examiner pointed to column 3, line 15-45 and Figures 4-6, 8, 9a, 10 and 14 of Kitchen to support his contention that Kitchen discloses the transmission of a bill including a charge and a location identifier of non-bill

information upon which the charge is based. These citations, however, fail to disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based. The text of column 3, lines 15-45 is reproduced below:

In a typical operational sequence, the processor accesses the memory to read the stored billing information. Using this information, the processor generates bill presentment information which corresponds to a portion of the billing information which represents bills for a first payor. The processor also generates bill presentment information which corresponds to other portions of the billing information which represents bills for other payors. The bill presentment information may relate to paid bills, unpaid bills or bills having another desired status, or any combination thereof. The bill presentment information, may be a detailed bill which includes all the applicable billing information, could be a summary of the applicable billing information, or could be a simple retransmission of all or some of the applicable billing information. Some or all of the bill presentment information may also be stored in the memory.

Preferably, the bill presentment information includes a summary listing of all bills of a desired status, such as all paid or unpaid bills. Beneficially, the bill presentment information includes a listing of respective billed amounts owed by the payor to a number of the different billers, which can be presented as one or more pages on a display, such as the monitor of a payor's home or office computer. The bill presentation information could also include a formatted version of all the applicable billing information, such as a full detailed

presentation of a bill, which can be presented on a display so as to appear substantially similar to the conventional hardcopy bills which are regularly received by mail today.

The cited text discloses that bill presentment information generated by the Kitchen system may include bills of a payer; however, nothing in the cited text discloses that a bill includes a charge and a location identifier of non-bill information upon which the charge is based. With respect to the information included in a bill, the above cited text only discloses that a bill summary or a full detailed bill may be displayed. The full detailed bill may be similar to a conventional hardcopy bill that is sent by mail. Nothing in the cited text relied on by the Examiner discloses a bill that includes a charge and a location identifier of non-bill information upon which the charge is based.

Additionally, the Figures relied on by the Examiner fail to disclose a bill including a charge and a location identifier of non-bill information upon which the charge is based. Figures 4-6 illustrate enrollment screens that are presented to an existing or potential payer upon request. These screens are not presented to the payer in conjunction with any particular bill, but instead to register the payer with the electronic payment system or adjust the preferences of the payer within the electronic payment system. Figure 4 illustrates an initial enrollment screen from which a payer can select billers that the payer would like to have the payment system pay electronically (column 10, line 64 – column 11, line 13). Figure 5 illustrates a further enrollment screen that facilitates the gathering of payer data which is necessary or desirable for the processing of bills (column 11, lines 14-19). At this screen, a payer enrolling with the system can enter personal information that may be used by the system in electronic presentation and

processing of bills such as the payer's name and address (column 11, lines 19-28). Figure 6 illustrates another enrollment screen at which a payer can fill in the fields of a personal check that the system can use in the future to pay bills by paper check rather than by electronic funds transfer (column 11, lines 41-49). Additionally, at Figure 6, a payer can enter login information for the system in the form of a user name and password to complete the enrollment process (column 11, lines 49-56).

Figures 4-6 do not disclose the transmission of a bill, much less a location identifier of first non-bill information upon which the charge is based. The Examiner contends that the personal information entered in Figure 5 is first non-bill information and that the banking and login information entered in Figure 6 is second non-bill information (Non-Final Office Action, page 3). The Examiner, however, fails to recognize the distinction between non-bill information upon which the charge is based, such as an underlying provision of a contract between the customer and biller, and a location identifier of that non-bill information, such as a hyperlink to the contract provision. In doing so, the Examiner fails to show that the personal information and banking and login information are location identifiers of non-bill information included in a transmitted bill upon which charges of the bill are based.

Furthermore, it is unclear as to how any entered banking and login information could be "information upon which a charge is based." As discussed in column 11, lines 41-56 of the Kitchen patent, the banking and login information of Figure 6 is not the basis upon which any charges of a bill are based. The first information entered in Figure 6 relates to the fields of a personal check that the system can use in the future to pay bills by paper check rather than by electronic funds transfer (column 11, lines 41-49). This check information relates to the payment

of future bills, not to any particular bill charges that might be presented to a payer. The purpose of this information is to be able to print paper checks or other drafts in order to pay bills. In no way does the information relate to any charge that might appear on the future bill. Accordingly, the check information cannot be non-bill information upon which a charge is based.

The second information entered in Figure 6 relates to login information for the service provider disclosed by Kitchen. This login information is stored by the system and used to verify the identity of a payer when he/she accesses the service provider in the future (column 11, lines 49-56). As with the check information, the login information is not information upon which a charge in bill can be based.

Even if it is found that banking and login information is non-bill information upon which a charge is based, Kitchen still fails to disclose that the banking and login information is transmitted to a payer in response to a request from the payer for the non-bill information by the selection of a location identifier of the non-bill information included in an electronic bill, as required by each of the independent claims of the present invention.

Figure 8 also fails to disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based. Figure 8 depicts a welcome screen that is transmitted to a payer after the payer access the service provider (column 12, lines 55-59). The welcome screen, which is not a bill, includes notifications of bills and messages that have not been previously transmitted to the payer (column 12, lines 59-65). The welcome screen also provides links to previously transmitted billing information including unpaid bills, paid bills, and previously accessed messages (column 12, line 66 – column 13, line 6). Additionally, the welcome screen provides a link to categories of bills such as, for example, utility bills of the

payer (column 13, lines 6-11). The welcome screen also provides a link to customer care at which a payer can enter a topic of interest or select a topic of interest from a pull down list (column 13, lines 7-47).

Figure 8, however, fails to disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based. Figure 8 discloses a screen at which a payer can choose to view new bills or previously presented paid or unpaid bills. A bill is not presented to the payer at Figure 8. Similarly, the contents of a bill available to a payer by the service provider are not disclosed at Figure 8. Accordingly, no bill including a charge and a location identifier of non-bill information upon which the charge is based is transmitted to the payer at Figure 8.

Figure 9a also fails to disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based. Figure 9a of Kitchen may be presented to a payer after the payer selects the new bill link at Figure 8 (column 13, lines 48-50). At Figure 9a, summary information of new bills is transmitted to the payer. The summary information includes the biller name, amount of the new bill and the due date for payment of the bill (column 13, lines 56-62). Additionally, the payer is given the option of paying, marking or deleting each bill presented in Figure 9a (column 13, line 63 – column 14, line 15). If the payer chooses to mark a bill and then clicks on the retrieve button shown in Figure 9a, then detailed bill information may be transmitted to the payer (column 13, line 63 – column 14, line 15). This detailed bill information is discussed below with reference to Figure 11.

Figure 9a does not disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based. Figure 9a presents bill

summary information including the name of a biller, the amount of the bill, and the due date of the bill. This information is merely bill summary information, not a bill. Additionally, the billing information disclosed in Figure 9a does not include a location identifier of non-bill information upon which the charge is based. Instead, Figure 9a only includes options for paying a bill, deleting a bill, or accessing detailed information about a bill. None of these options constitutes a location identifier of non-bill information upon which a charge is based.

If a payer chooses to mark a bill and then click on the retrieve button, Figure 11 will be presented to the payer. Figure 11, which was cited by the Examiner in the Final Office Action of March 23, 2006, presents detailed bill presentment information to a payer responsive to a request for such information by a payer (column 15, lines 58-65). As shown in Figure 11, the detailed information includes the information that would typically be sent to the payer as a traditional paper bill. Figure 11 illustrates a telephone bill and breaks down all of the service charges related to the payers telephone usage. Figure 11 also includes personal information relating to the payer and a logo of the biller.

Figure 11, however, does not disclose a bill including a charge and a location identifier of non-bill information upon which the charge is based. While Figure 11 does itemize the charges presented in the bill, none of the listed itemizations constitute location identifiers of non-bill information upon which the charge is based. In other words, a payer cannot select the “taxes” item of the bill presented in Figure 11 and receive, responsive to that selection, non-bill information upon which the “taxes” charge is based. In fact, the only location identifiers or links disclosed in Figure 11 are links to pay the bill or to delete the bill. Neither of these location identifiers constitute a location identifier of non-bill information upon which a charge is based.

They simply allow a payer to pay or select the bill presented in Figure 11. Accordingly, Figure 11 fails to anticipate the present invention because it fails to disclose a location identifier of non-bill information upon which a charge is based.

Figure 10a also fails to disclose a bill including a charge and non-bill information upon which the charge is based. Figure 10a illustrates a prebill payment authorization screen that can be transmitted to a payer by the service provider (column 15, lines 8-13). The prebill payment authorization screen allows a payer to identify billers whose bills are pre-authorized by the payer for payment by the service provider (column 15, lines 13-16). The payer can designate a fixed payment amount, a maximum payment amount, or an instruction to pay the total amount due or minimum amount due to a biller (column 15, lines 16-18). The payer can also designate a frequency at which these payments are to be made (column 15, lines 18-20). Additionally, the payer may authorize payment of part or the total amount of all of the bills received by the service provider from billers for the payer (column 15, lines 21-36).

Figure 10a is similar to the enrollment screens of Figures 4-6 in that it is transmitted to a payer prior to the transmission of a bill to the payer. Accordingly, Figure 10a fails to disclose the transmission of a bill that includes a charge and a location identifier of non-bill information upon which the charge is based. No bill is transmitted to a payer in Figure 10a. Additionally, no charge is transmitted in Figure 10a. Furthermore, no location identifiers of non-bill information upon which a charge is based are transmitted in Figure 10a. Thus, Figure 10a does not disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based, as required by each of the independent claims of the present application.

Additionally, Figure 14 fails to disclose a bill including a charge and a location identifier of non-bill information upon which the charge is based. Figure 14 depicts a screen that allows a payer to establish certain categories of billers (column 17, lines 18-22). As shown in Figure 14, categories may be established for utilities, credit card companies, school, tennis related activities and other categories desired by an individual payer (column 17, lines 22-29).

Figure 14 is not related to any particular bill that is transmitted to a payer. Instead, Figure 14 is used to categorize the various billers of a payer. As with the enrollment screens of Figures 4-6, the categorization screen of Figure 14 can be accessed by a payer prior to any bill ever being transmitted to the payer. Figure 14 does not disclose the transmission of a bill to a payer. Because no bill is transmitted, Figure 14 also fails to disclose the transmission of bill including a charge and a location identifier upon which the charge is based, as required by each of the independent claims of the present application.

In the Final Office Action, the Examiner added Figure 11 of Kitchen to his rejection in order to argue that the transmission of personal information such as a name and address on an electronic billing notice constitutes the transmission of non-bill information. The Examiner argued that Figure 11 discloses the transmission of a bill at the bottom of the page and the transmission of non-bill information in the form of personal information of the payer and biller at the top of the page.

As discussed above, Figure 11 fails to disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based. The personal information cited by the Examiner does not constitute a location identifier that may be selected by the payer. Contrarily, the personal information is plain text that does not reference

the location of any additional information. Additionally, the personal information cited by the Examiner does not constitute information upon which the charge is based. Personal information of a payer or biller only identifies the parties to the bill. It does not form the basis of a particular charge in the bill.

Furthermore, the personal information cited by the Examiner fails to constitute non-bill information because it is information that typically appears on a bill. The Specification of the present invention states that bill information includes any information traditionally included with bills presented to customers, and non-bill information includes information other than traditional bill information (Specification, Paragraph 50). Because the personal information of a payer and biller such as names and addresses typically appears on a bill, it does not constitute non-bill information. Accordingly, FIG. 11 fails to disclose the transmission of a bill including a charge and a location identifier of non-bill information upon which the charge is based.

It should be apparent from the above that the Examiner has not established a *prima facie* basis for the rejection of independent Claims 1, 9, 18, 23, 29 and 30 in the Final Official Action. Because the Examiner has failed to demonstrate that Kitchen discloses all of the claim limitations recited in the independent claims of the present application, the Examiner's rejection is in error. Because the independent claims are patentable over the cited prior art, all of the dependent claims of the present application are allowable as a matter of law.

C. KITCHEN DOES NOT DISCLOSE A FIRST NON-BILL INFORMATION THAT IS
A FIRST PORTION OF A DOCUMENT AND A SECOND NON-BILL
INFORMATION THAT IS A SECOND PORTION OF THE SAME DOCUMENT

Dependent Claims 2 and 10 of the present invention depend from independent Claims 1 and 9 respectively. Independent Claims 1 and 9 require the transmission of a bill including a first charge, a second charge, a location identifier of first non-bill information upon which the first charge is based, and a location identifier of second non-bill information upon which the second charge is based. Dependent Claims 2 and 10 then claim that the first non-bill information is a first portion of a document, and the second non-bill information is a second portion of a document. Accordingly, multiple location identifiers may be used to reference the same document or even to index a particular document. For example, if an insurance bill is presented to a payer, the first non-bill information may constitute a first portion of the underlying insurance contract and the second non-bill information may constitute a second portion of the same underlying insurance contract.

The Examiner contends that Figures 4-6 and 11 anticipate dependent Claims 2 and 10. The Examiner contends that in each of Figures 4-6 and 11, the various personal information elements disclosed are part of the same presented screen or document. For example, if a transmitted screen contains two items of personal information, such as both a name and an address, then the transmitted screen constitutes a signal document containing both first non-bill information and second non-bill information.

However, by failing to show that Figures 4-6 and 11 of Kitchen disclose location identifiers of non-bill information, the Examiner has failed to show that a first location identifier

references a first portion of a document and that a second location identifier references a second portion of the same document, as required by the present application. The Examiner's argument is only that a single document contains two items of non-bill information. The Examiner, therefore, fails to demonstrate that a bill discloses a first location identifier of non-bill information that references a first portion of a document, and a second location identifier of non-bill information that references a second portion of the same document. Accordingly, the Examiner, has clearly erred by failing to demonstrate that Kitchen anticipates Claims 2 and 10 of the present invention.

D. KITCHEN DOES NOT DISCLOSE A BILL BEING TRASNMITTED BY A BILL PRESENTMENT SERVER AND NON-BILL INFORMATION BEING TRANSMITTED BY A NON-BILL PRESENTMENT SERVER

Dependent Claims 5, 15, and 27 of the present invention depend from independent Claims 1, 9 and 23 respectively. Dependent Claim 5 recites that the bill including a charge and a location identifier of non-bill information upon which the charge is based is transmitted to a payer by a bill presentment server and that requested non-bill information is transmitted to the payer by a non-bill presentment server. Similarly, dependent Claims 15 and 27 claim that a network station associated with a bill presentment service provider transmits the bill including a charge and a location identifier of non-bill information upon which the charge is based, and a network station associated with a biller transmits requested non-bill information.

In the Non-final Office Action dated October 4, 2005, the Examiner addressed Claims 5, 14, and 26 together. Claims 14 and 26, however, claim that a single server transmits both the bill

and non-bill information to a payer. Accordingly, for purposes of this Appeal, the Applicants contend that Claims 5, 15, and 27 should be grouped together.

In rejecting dependent Claim 5, the Examiner argued that Figures 8-9b of Kitchen teach that the bill, including a charge and location identifier of non-bill information, is transmitted to the payer by a bill presentment server; and the non-bill information is transmitted to the payer by a non-bill presentment server.

However, as discussed in detail above, Figures 8 and 9a of Kitchen illustrate screens displayed to a payor that is using the bill presentment system. Figure 8 is a welcome screen that alerts a payer to any messages or bills that are available when the payer logs onto the bill presentment system (column 12, line 59 – column 13, line 47). Figure 9a may be presented to a payer after the payer selects the new bill link at Figure 8 (column 13, lines 48-50). At Figure 9a, summary information of new bills is transmitted to the payer. The summary information includes the biller name, amount of the new bill and the due date for payment of the bill (column 13, lines 56-62).

Figure 9b depicts a screen that displays categorized bills to a payer (column 14, lines 16-19). A payer may select a category of bills such as, for example, unpaid bills or utility bills, and a summary list of the bills in that category are presented to the payer (column 14, lines 19-26). The payer can then selectively pay the bills in a displayed category by checking boxes next to each displayed summary bill information (column 14, lines 26-33).

The Examiner never explained his reasons for why he believes Figures 8-9b anticipate Claims 5, 15, and 27 of the present invention. He simply pointed to the Figures with no explanation in the Non-final Office Action and then failed to address the issue in the Final Office

Action after the Applicants objected to the earlier rejection. Accordingly, the Applicants can only guess as to the Examiner's reasoning behind making the rejection. The Examiner, therefore, has failed to provide sufficient factual basis or rationale as to how the features of Claims 5, 15, and 27 are taught or suggested by Kitchen. That is, the Examiner has failed to present objective evidence in support of the rejection. Without such support, the rejection is improper *per se*.

Accordingly, for at least the reasons stated above, the Examiner has failed to establish a *prima facie* case that Kitchen anticipates dependent Claims 5, 15, and 27 of the present invention.

XI: CONCLUSION

It is respectfully submitted that the Examiner has (i) failed to establish a *prima facie* case for rejection, (ii) ignored features explicitly required by the claims, (iii) failed to reasonably construe that which is taught and suggested by the applied prior art combination, and (iv) has applied art in a manner inconsistent with its teachings.

Thus, it is respectfully submitted that the rejection of claims 1-16, and 18-30 under 35 U.S.C. § 102 (b) as being anticipated by Kitchen is improper.

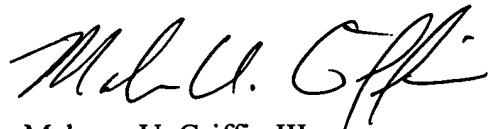
In summary, Applicants respectfully submit that the applied art does not teach or suggest features recited in each of the rejected independent Claims 1, 9, 18, 23, 29, and 30 upon which all other pending claims depend. It is further respectfully submitted that the applied art also fails to disclose numerous other features recited in the pending dependent claims. Accordingly, it is submitted that the applied art does not provide any teaching, or suggestion within its teachings, which would lead to the features (or advantages) of the instant invention, and the claims patentably define over the art.

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The rejection of the claims is in error and reversal is clearly in order and is courteously solicited.

It is not believed that extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



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Attorney Docket No.: **23952-0145**

APPENDIX OF CLAIMS ON APPEAL

Claim 1: A method for presenting a bill and associated non-bill information via a network, comprising;

transmitting to a payer, via a network, a bill including a first charge, a second charge, a location identifier of first non-bill information upon which the first charge is based, and a location identifier of second non-bill information upon which the second charge is based;

receiving from the payer, via the network, a request for at least one of the first non-bill information and the second non-bill information; and

transmitting to the payer, via the network, the requested non-bill information in response to the received request.

Claim 2: The method of claim 1, wherein:

the first non-bill information is a first portion of a document; and

the second non-bill information is a second portion of the same document.

Claim 3: The method of claim 2, wherein the document is one of a contract, a tariff, or a warranty.

Claim 4: The method of claim 1, wherein the location identifier of the first non-bill information includes a first hyper-link and the location identifier of the second non-bill information includes a second hyper-link, and further comprising;

activating at least one of the first hyper-link and the second hyper-link to request non-bill

information.

Claim 5: The method of claim 1, wherein:

the bill, including the location identifier of the first non-bill information and the location identifier of the second non-bill information, is transmitted to the payer by a bill presentment server; and
the non-bill information is transmitted to the payer by a non-bill presentment server.

Claim 6: The method of claim 5, wherein:

the bill presentment server is associated with a bill presentment service provider; and
the non-bill presentment server is associated with a biller.

Claim 7: The method of claim 1, wherein the bill is one of a detailed bill or a summary bill.

Claim 8: The method of claim 1, wherein the bill further includes a location identifier of non-bill information other than non-bill information upon which a charge is based.

Claim 9: A system for presenting a bill and associated non-bill information, comprising:

a first network station configured to transmit, via a network, a bill including a first charge, a second charge, a location identifier of first non-bill information upon which the first charge is based, and a location identifier of second non-bill information upon which the second charge is based; and

a second network station configured to receive the transmitted bill, to transmit request for at least one of the first non-bill information and the second non-bill information via the network, and to receive the requested non-bill information via the network.

Claim 10: The system of claim 9, wherein:

the first non-bill information is a first portion of a document; and
the second non-bill information is a second portion of the same document.

Claim 11: The system of claim 9, wherein the bill is one of a summary bill or a detailed bill.

Claim 12: The system of claim 9, wherein the document is one of a contract, a tariff, or a warranty.

Claim 13: The system of claim 9, wherein:

the location identifier of the first non-bill information includes a first hyper-link;
the location identifier of the second non-bill information includes a second hyper-link; and
the second network station is further configured to activate the first hyper-link to request the first non-bill information and to activate the second hyper-link to request the second non-bill information.

Claim 14: The system of claim 9, wherein:

the first network station is further configured to store the first non-bill information and the second non-bill information, receive the request for non-bill information, and transmit the requested

non-bill information to the second network station via the network;

the first network station is associated with one of a biller or a bill presentment service provider;
and

the second network station is associated with a payer;

Claim 15: The system of claim 9, further comprising:

a third network station configured to store the first non-bill information and the second non-bill information, receive the request for non-bill information, and transmit non-bill information to the second network station via the network;

wherein the first network station is associated with a bill presentment service provider, the second network station is associated with a payer, and the third network station is associated with a biller.

Claim 16: The system of claim 9, wherein the bill further includes a location identifier of non-bill information other than non-bill information upon which a charge is based.

Claim 17 (Cancelled)

Claim 18: A method for presenting a bill and associated non-bill information via a network, comprising:
transmitting to a payer, via a network, a bill including a charge and a location identifier of a portion of non-bill information upon which the charge is based;

receiving from the payer, via the network, a request for the portion of non-bill information; and

transmitting to the payer, via the network, the portion of non-bill information in response to the received request.

Claim 19: The method of claim 18, wherein the bill is one of a detailed bill or a summary bill.

Claim 20: The method of claim 18, wherein the non-bill information is one of a contract, a tariff, or a warranty.

Claim 21: The method of claim 18, wherein:

the bill including the location identifier is transmitted by one of a bill presentment service provider or a biller; and

the portion of non-bill information is transmitted by the biller.

Claim 22: The method of claim 18, wherein:

the location identifier is a first location identifier; and

the bill further includes a second location identifier of non-bill information other than non-bill information upon which a charge is based.

Claim 23: A system for presenting a bill and associated non-bill information via a network, comprising:

a first network station configured to transmit, via a network, a bill including a charge and a location identifier of a portion of non-bill information upon which the charge is based; and

a second network station configured to receive the transmitted bill, to transmit request for the portion of non-bill information, and to receive the requested portion of non-bill information via the network.

Claim 24: The system of claim 23, wherein the bill is one of a summary bill or a detailed bill.

Claim 25: The system of claim 23, wherein the non-bill information is one of a contract, a tariff, or a warranty.

Claim 26: The system of claim 23, wherein:

the first network station is further configured to store the non-bill information, receive the request for the portion of non-bill information, and transmit the requested portion of non-bill information to the second network station via the network;

the first network station is associated with one of a biller or a bill presentment service provider; and

the second network station is associated with a payer.

Claim 27: The system of claim 23, further comprising:

a third network station configured to store the non-bill information, receive the request for the

portion of non-bill information, and transmit the requested portion of non-bill information to the second network station via the network;

wherein the first network station is associated with a bill presentment service provider, the second network station is associated with a payer, and the third network station is associated with a biller.

Claim 28: The system of claim 23, wherein:

the location identifier is a first location identifier; and

the bill further includes a second location identifier of non-bill information other than non-bill information upon which a charge is based.

Claim 29: An article of manufacture for presenting a bill and associated non-bill information via a network, comprising:

a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

transmit, via a network, a bill including a first charge, a second charge, a location identifier of first non-bill information upon which the first charge is based, and a location identifier of second non-bill information upon which the second charge is based;

receive, via the network, a request for at least one of the first non-bill information and the second non-bill information; and
transmit, via the network, the requested non-bill information.

Claim 30: An article of manufacture for presenting a bill and associated non-bill information via a network, comprising:

a computer readable medium; and
computer programming stored on the medium;
wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

transmit, via a network, a bill including a charge and a location identifier of a portion of non-bill information upon which the charge is based;

receive, via the network, a request for the portion of non-bill information; and

transmit, via the network, the portion of non-bill information.